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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,990	04/27/2001	John R. Wolf	D-42816-02	1833
28236	7590	09/22/2005	EXAMINER	
CRYOVAC, INC. SEALED AIR CORP P.O. BOX 464 DUNCAN, SC 29334			GERRITY, STEPHEN FRANCIS	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 09/22/2005

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**Group 3700**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/843,990  
Filing Date: April 27, 2001  
Appellant(s): WOLF ET AL.

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Rupert B. Hurley, Jr.  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 30 June 2005 appealing from the Office action mailed 6 May 2004.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

United States patent application serial number 10/041,129 is a related application for which an Examiner's Answer has been mailed. The subject matter of the application and arguments presented both by appellant and the examiner may have a bearing on the Board's decision in this pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claim 21-23 and 25-33.

Claim 24 has been canceled.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: claim 24 is cancelled accordingly the rejection is withdrawn and arguments with regard to that claim are moot.

**WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner: the rejection of claim 24 is withdrawn because claim 24 has been cancelled -- see the amendment filed 12/1/2003.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

A substantially correct copy of appealed claims 21-23 and 25-33 appears on pages 19-21 of the Appendix to the appellant's brief. The minor errors are as follows: claim 24 should not appear in the appendix because it has been canceled.

**(8) Evidence Relied Upon**

US 3,919,549	Gill et al.	11-1975
US 4,469,742	Oberle et al.	9-1984

Appellant's admitted prior art concerning Nishimoto et al. (US 5,336,549)

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-23, 25-27 and 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appellant's Admitted Prior Art (AAPA) concerning Nishimoto et al. (5,336,549) in view of in view of Gill et al. (3,919,033).

The Board's attention is directed to paragraph 2, pages 2-4, of the Final Office action, mailed 6 May 2004.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Appellant's Admitted Prior Ad (AAPA) concerning Nishimoto et al. (5,336,549) in view of in view of Gill et al. (3,919,033), and further in view of Oberle et al. (4,469,742).

The Board's attentions is directed to paragraph 4, page 5, of the Final Office action, mailed 6 May 2004.

**(10) Response to Argument**

Appellant first argues that the examiner has failed to establish a prima facie case of obviousness of any one or more of claims 21-23, 25-27 and 29-33. Appellant critiques the Nishimoto et al. reference at pages 8 and 9 and contends that Nishimoto et al. utilizes a polyamide having a different melting point that that which is claimed, that is

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one that is higher than that which is claimed. In particular, appellant argues that Nishimoto et al. is teaching away from lowering the melting point to that which is claimed. Additionally, appellant argues that it would be improper to look to the Gill et al. reference because it is considered by appellant as being non-analogous as it is directed to an adhesive which is a polyamide with the particular melting point in question. And even if viewed as analogous art, appellant argues that it would be improper to combine the teachings of Nishimoto et al. and Gill et al. because the suggestions of Gill et al. run contrary to what Nishimoto et al. teaches as being detrimental, that is, a lower melting point temperature.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation comes from the references themselves and it is not repugnant for the teachings to come from a reference which may appear to be non-analogous. Furthermore, in response to appellant's argument, the fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

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In response to appellant's argument that Gill et al. is nonanalogous art, it has been held that a prior art reference must either be in the field of appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the appellant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, a skilled artisan would be likely to consider the Gill et al. reference analogous art because it is concerned with the same technology. The use of polyamide to bond layers together, and to do so at a lower melting point -- that is a lower temperature -- which is always desirable in order to save money on production of the material in question. It seems that the Gill et al. reference is quite within the field of appellant's endeavor and to be reasonably pertinent to the particular problem with which the appellant was concerned.

In response to appellant's argument that Oberle et al. cannot be combined with Nishimoto et al. and Gill et al. to arrive at the subject matter of claim 28, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Conferees:

John Sipos

Louis Huynh



Stephen F. Gerrity  
Primary Examiner